

REMARKS / ARGUMENTS

Reconsideration of the application as amended is respectfully requested.

Before entry of the present amendment, Claims 1-6 were the subject of an appeal before the Board of Appeals and Interferences. The examiner has since withdrawn the final rejection and reopened prosecution. At present, Claims 1-6 stand rejected.

The specification and figures were objected to, respectively, for not showing what was described at page 6, lines 4-6 and page 7, lines 4-6. The figures have been separately amended to overcome this objection.

Claim 1 was objected to for claiming "heating elements" when only a single heating element was disclosed. Claim 1 has been amended to reflect this element, thereby overcoming the examiner's objection.

The examiner respectfully rejected Claims 1-3 under 35 U.S.C. § 102(b) as being anticipated by Vaneslow.

In undertaking to determine whether one reference anticipates the claim(s) of an application under 35 U.S.C. § 102(b), a primary tenet is that the reference must teach every element of the claim(s). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Vaneslow discloses and claims a cup warming device having a receiving member with an extended cylindrical cavity. In contrast, the present invention includes a number of features unanticipated by Vaneslow, including:

- 1 • a heating element retained within the base (as opposed to a heating element in the receiving member 20 and central bore 23)
- 2 • the capability of the present invention to use a standard drinking mug with the base element for warming and maintaining warm beverages
- 3 • a base with an upstanding wall that circumscribes a lower portion of the mug or beverage holder but without interfering with the handle of the mug
- 4 • insulating media to entrap the warmth to the beverage and prevent users from being harmed by heated beverage

In light of the differences stated above, Vaneslow fails to disclose or claim every element of Claims 1, 2 and 3 as required, therefore, Claims 1-3 are considered allowable.

The examiner respectfully rejected Claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Vaneslow in view of Dam.

The examiner respectfully rejected Claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Vaneslow in view of Gordon.

In undertaking a determination of whether a reference, or a combination of references, renders a claim(s) obvious under 35 U.S.C. § 103(a), the examiner must show that the reference or combination of references teach or suggest every element of the claim(s) in question. MPEP § 706.02(j).

As to Claim 4, Dam is cited as disclosing in Figures 1-5 and Column 8, Lines 30-39, a heated drinking mug utilizing either AC or DC power, and that it would have been obvious to adapt the mug of Vaneslow to accommodate AC power as taught by Dam. Claim 4 presently depends from a claim (Claim 1) that is considered allowable over the cited art, therefore Claim 4 is also considered allowable.

As to Claims 5 and 6, neither Vaneslow nor Gordon, apart of in combination, disclose, teach, claim or *suggest* every element of Claims 5 or 6, including a flexible resistive heating element. And because Claims 5 and 6 depend from a claim (Claim 1) that is considered allowable, Claims 5 and 6 are presently considered allowable.

Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. § 103(a), in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103(a), the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

*more
hindsight*

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). There is nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of making a heated mug apparatus having a heating element powered by a vehicle's electrical system, thereby heating any beverage contained therein, and wherein the drinking mug is flexibly retained in firm mechanical contact with a base element. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (Fed. Cir. 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (Fed. Cir. 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (Fed. Cir. 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements.

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To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (Fed. Cir. 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (Fed. Cir. 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and a formal Notice of Allowance is respectfully requested at the earliest possible date.

Respectfully submitted,

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